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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,401	01/14/2004	Motonao Nakao	HIRA.0134	3504
7590	01/19/2006		EXAMINER	
Reed Smith LLP Suite 1400 3110 Fairview Park Drive Falls Church, VA 22042-4503			JUNG, UNSU	
			ART UNIT	PAPER NUMBER
			1641	

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/756,401

Applicant(s)

NAKAO, MOTONAO

Examiner

Unsu Jung

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5 and 12, drawn to a functional bead, classified in class 422, subclass 57, for example.
  - II. Claim 6, drawn to a method for reading beads by applying a voltage to functional beads in a flow path, classified in class 436, subclass 525, for example.
  - III. Claims 7, 8, and 15, drawn to a bead reading apparatus comprising a flow path, a pair of electrodes, a power source, and a light-receiving element, classified in class 435, subclass 288.7, for example.
  - IV. Claim 9, drawn to a method for reading beads by irradiating functional beads with an electromagnetic wave in a flow path, classified in class 435, subclass 4, for example.
  - V. Claims 10, 11, and 16, drawn to a bead reading apparatus comprising a flow path, an electromagnetic wave source, and a light receiving element, classified in class 435, subclass 287.1, for example.
  - VI. Claims 13 and 14, drawn to a method for reading functional beads by providing a bead reading apparatus, classified in class 435, subclass 287.2, for example.

Art Unit: 1641

2. The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process. For example, the product of Group I can be used in methods of Groups IV and VI.

4. Inventions I, III, and V are independent and patentably distinct. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the product of Group I includes a functional bead comprising a coating layer on a surface and nanoparticles present in the coating layer, which are not required by the apparatuses of Groups III and V. The apparatus of Group III includes a pair of electrodes, which are not required by the product of Group I and apparatus of Group V. The apparatus of Group V includes an electromagnetic wave source, which is not required by product of Group I and apparatus of Group III. Therefore, the inventions of Groups I, III, and V have different modes of operation.

Art Unit: 1641

5. Inventions II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used in a materially different process. For example, the apparatus as claimed can be used in a method to detect cells labeled with nanoparticles.

6. Inventions II, IV, and VI are independent and patentably distinct. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the method of Group II includes a step of enabling functional beads to emit light with a wavelength specific to nanoparticles by applying a voltage to the functional beads in the flow path. This step is not required by the methods of Groups IV and VI. The method of Group IV includes steps of irradiating functional bead with an electromagnetic wave and identifying functional beads based on the emission. These steps are not required by the methods of Groups II and VI. The method of Group VI includes a step of identifying functional beads based on a specific reaction between a first biopolymer and a second biopolymer. This step is not required by the methods of Groups II and IV. Therefore, the methods of Groups II, IV, and VI have different modes of operation.

Art Unit: 1641

7. Inventions IV and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process. For example, the apparatus of Group III can be used in the method of Group VI.

8. Inventions VI and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process. For example, the apparatus of Group III can be used in the method of Group IV.

9. Inventions IV and V are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and

Art Unit: 1641

materially different process. For example, the apparatus of Group V can be used in the method of Group VI.

10. Inventions VI and V are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process. For example, the apparatus of Group V can be used in the method of Group IV.

11. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art because of their recognized divergent subject matter, and searches for one group are not required by the others, restriction for examination purposes as indicated is proper.

12. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art Unit: 1641

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Unsu Jung whose telephone number is 571-272-8506.

The examiner can normally be reached on M-F: 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Unsu Jung, Ph.D.  
Patent Examiner  
Art Unit 1641



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01/13/06